

REMARKS

In response to the Office Action dated December 29, 2008, Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims. Claims 32 to 34 are new and claims 13 and 18 have been amended as recommended by the Examiner. Accordingly, claims 1, 6, 7, 12, 13, 18 and 20 to 34 are currently pending. Support for new claims 32 to 34 may be found in the specification, at, for example, FIGs. 1, 2, 5 to 10 and paragraphs 38, 40, 46, 52, 53, 55, 57, 58 and 60 of Applicant's specification.

Claim Rejection under 35 U.S.C. § 101

The Office Action rejected claims 13, 14 and 18 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter for being drawn to functional descriptive material recorded on a computer readable medium.

Applicant has amended claims 13 and 18, as suggested by the Examiner, to obviate the rejection under 35 U.S.C. § 101. Accordingly, Applicant respectfully requests the rejection be withdrawn.

Applicant has cancelled claim 14. Therefore, the rejection to claim 14 under 35 U.S.C. § 101 is moot.

Claim Rejection under 35 U.S.C. § 112, First Paragraph

Applicant notes that claims 21 to 23, 25 to 27 and 29 to 31 are not rejected by prior art under 35 U.S.C. §§ 102 or 103 in the Office Action.

The Office Action alleges claims 21 to 23, 25 to 27 and 29 to 31 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees and submits the specification meets the written description requirement for each of the claims.

"The subject matter of the claim need not be described literally (i.e., using the same terms *in haec verba*) in order for the disclosure to satisfy the written description requirement. (M.P.E.P. § 2163.02).

Specifically, the Office Action alleges "nowhere in the specification is specifically referred to as a first judgment unit and a second judgment unit where the second judgment unit individually judges whether each of the documents transported is an electronically tagged printer matter." (Office Action, p. 3).

Initially, the terms "first" and "second" are simply used as adjectives to describe a first judgment unit (143A) and a second judgment unit (143B). (Applicant's specification, Figure 2). Moreover, the terms "first" and "second" are used as ordinal numbers to identify the different judgment units corresponding to a first judgment unit (143A) and a second judgment unit (143B). (*Id.*).

Support for "a first judgment unit for judging whether a series of documents set on a document tray contains at least one electronically tagged printed matter that includes an electronic tag storing original image data" can be found at least at Applicant's specification, p. 9, line 24-p. 10, line 2 and p. 14, line 22-p. 15, line 2.

Additionally, support for "a second judgment unit for individually judging whether each of the documents by the transporting unit is an electronically tagged printed matter" can be found at least at Applicant's specification, p. 4., lines 18-20, p.5, lines 8-10 and p. 5, line 23-p. 6, line 1.

However, the present invention is not limited to the preferred disclosed embodiments.

Accordingly, Applicant respectfully request the rejection under 35 U.S.C. § 112, first paragraph, of claims 21 to 23, 25 to 27 and 29 to 31 be withdrawn and the claims allowed.

Claim Rejections under 35 U.S.C. § 103

The Office Action rejected claims 1, 6, 7, 13, 18, 20, 24 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Teraura (U.S. 6,827,279) in view of Ojha (U.S. 4,987,447) and further in view of Nishigai et al. ("Nishigai") (U.S. 5,825,911).

Teraura, Ojha and Nishigai cannot support a rejection of independent claims 1, 7, 13, 20, 24 and 28 under 35 U.S.C. § 103(a) because, taken individually or in combination, these references lack disclosing, teaching, or suggesting the subject matter recited in the claims. (See M.P.E.P. § 2143.03).

The Office Action concedes Teraura does not disclose, teach, or suggest "an electronic tag storing original image data" as recited in claim 1. Moreover, Applicant respectfully submits Teraura also lacks disclosing, teaching, or suggesting "a printing paper judgment unit for judging whether there is an instruction for printing the original image data" as recited in claim 1.

The Office Action alleges Teraura discloses "a printing paper judgment unit for judging whether there is an instruction for printing image data on an electronically tagged printing paper equipped with an electronic tag (**i.e., paper feeding means having a first paper tray with electronic tags and second paper tray with paper without electronic tags, when a detection of electronic tag is done the printer prints using the electronically tagged paper. See Column 1, Lines 30-65 and Column 2, Lines 1-26**)." (Office Action, p. 4). Applicant respectfully disagrees that Teraura's "detection" of an electronic tag is an "instruction for printing image data."

Instead, in Teraura's copying embodiment, a copy machine may comprise a detecting means for determining whether a document includes an RFID tag. (Teraura, Column 2, lines 13-16). When the copy machine detects that the document includes an RFID tag, the paper feeding means feeds a piece of paper with an RFID tag from a first paper tray and the printing means prints an image on the paper and records the RFID data in the RFID tag to the RFID tag on the piece of paper fed from the first paper tray. (*Id.*). When the copy machine detects that the document does not include an RFID tag, the paper feeding means feeds a piece of paper without an RFID tag and the printer means prints the image on the paper. (*Id.*). Therefore, Applicant respectfully asserts Teraura's determination of whether to print a document on a piece of paper with or without an RFID tag based on the copy machine detecting an electronic tag on the document being copied does not include "judging whether there is an instruction for printing the original image on an electronically tagged printing paper" as recited in claim 1.

The Office Action relies on Ojha to make up for the deficiencies of Teraura. The Office action alleges Ojha teaches "an image forming apparatus receiving original image data to be used for printing instructions." (Office Action, p. 5). Applicant respectfully disagrees.

Ojha teaches a reproduction apparatus having memory storing setup instructions which controls the operation of the reproduction apparatus. (Ojha, Column 1, lines 50-59). A control sheet is produced from the stored instruction signals bearing machine readable indicia corresponding to the stored setup instructions. (*Id.*). The coded information on the control sheet is converted to "setup instruction signals" for controlling the reproduction apparatus during subsequent

production runs. (*Id.*). Additionally, the control sheet can be inserted in a stack of originals to be copied so that the originals are copied by the reproduction apparatus according to the computer readable indicia printed on the control sheet. (Ojha, Column 3, lines 18-44). Moreover, the reproducing apparatus **must** recognize that the control sheet is **not** an **original** document to be copied. (**Emphasis added**). (*Id.*). Accordingly, Applicant respectfully asserts Ojha's control sheet cannot be "original image data" because the reproduction apparatus must recognize that the control sheet is not an original document.

The Office Action also alleges Nishigai teaches the "printing unit issues a blank paper as an output, when a document is judged not as an electronically tagged matter" as recited in claim 1. However, Applicant respectfully submits claim 1 is allowable for at least the reasons discussed above because Nishigai does not cure the deficiencies of Teraura and Ojha.

When Teraura, Nishigai, and Ojha are taken individually or in any combination, these patents lack supporting a rejection of claim 1 under 35 U.S.C. § 103(a) because the combination does not disclose, teach, or fairly suggest each element of claim 1. Accordingly, reconsideration and withdrawal of the rejections and allowance of the claims is respectfully requested.

Independent claims 7, 13, 20, 24, and 28, although having different scope than claim 1, recite similar features to those in claim 1. Accordingly, Applicant respectfully submits claims 7, 13, 20, 24, and 28 are also allowable over Teraura in view of Ojha and further in view of Nishigai.

Additionally, Applicant respectfully submits that claims 6, 12, 18, 22, 26, and 31 are allowable over Teraura in view of Ojha and further in view of Nishigai at least

due to their corresponding dependence from claims 1, 7, 13, 20, 24, and 28, respectively.

Moreover, Applicant respectfully submits that new claims 32, 33 and 34 are allowable over Teraura in view of Ojha and further in view of Nishigai at least due to their corresponding dependence from claims 1 and 21.


Conclusion

Reconsideration and withdrawal of the rejections, and allowance of all pending claims, are respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: April 27, 2009

By: 
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620